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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,068	07/15/2003	Kai H. Chang	Chang 6-17-28	7129

7590 08/15/2005

Fitel USA Corp.
Room 2H02
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Norcross, GA 30071

EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/620,068		CHANG ET AL.	
	Examiner		Art Unit	
	John Hoffmann		1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 June 2005 has been entered.

Election/Restrictions

Although Applicant had provisionally elected to prosecute the invention/specie of claim 10 during a telephone conversation with Michael Morra on 7-7-2005, Examiner decided to rejoin the other specie (i.e. claim 2).

Allowable Subject Matter

Except for the double patenting rejection (which can be overcome by a terminal disclaimer) claims 2 and 10 define are deemed to be allowable.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Backer 5180411 in view of Tuminaro 6496627 or Lemaire 5478371

**A method for making optical fiber, the method comprising the steps of:
forming a glass core rod by soot deposition, the glass core rod having a core
region surrounded by a cladding region,**

See Backer at col. 9, lines 34-42.

dehydrating the glass core rod;

See Backer at col. 13, lines 24-40.

consolidating the glass core rod to form an optical fiber preform;

See Backer at col. 10, lines 39-40.

drawing fiber from the optical fiber preform;

See Backer at figure 3.

**and exposing the drawn optical fiber to an atmosphere containing
deuterium at room temperature.**

Backer does not teach this. Tuminaro discloses that deuterium exposure results in improved long term signal attenuation performance. See col. 2, lines 47-60, and col, 3, line 40 to col. 4, line 9. It would have been obvious to improve the long term performance of the Backer fiber, by exposing it to deuterium as disclosed by Tuminaro. Col. 17 lines 56-59 discloses the room temperature exposure.

Using Lemaire instead: Lemaire teaches to treat fibers with deuterium at room temperature to make laser cavities, filters, multiplexers and demultiplexers (col. 1, lines 25-33, col. 2, lines 48-58). It would have been obvious to treat the Backer fiber with deuterium as taught by Lemaire so as to make laser cavities, filters, multiplexers and/or

demultiplexers, so that one can filter, multiplex, demultiplex, and/or do whatever one usually does with laser cavities.

Claim 3: Since Tuminaro does the same thing that applicant does (for substantially the same reason – to cure defects) one would expect substantially the same result.

Claim 8: See Backer, col. 9. lines 34-38.

Claims 4-6: see col. 9, lines 47-48 of Backer: the additional overcoating cladding soot is the same thing as “overclad”. The overclad would be dehydrated and consolidated the same time the rest of preform is dehydrated and consolidated.

Claim 9: the “thereafter” limitation is not given any patentable weight. It is deemed that patents only cover the past and present – not the future. No one has the ability to predict the future. Alternatively, it is deemed that “the aging loss” is interpreted as “an aging loss” It is deemed that an aging loss of an aging of 1 microsecond would clearly be less than 0.04 db/km. As to the transmission loss: Backer does not disclose the claimed loss. It would have been obvious to make perform the Backer/Tuminaro method, so that the fiber has the lowest possible transmission loss and the loss possible aging loss increase. It is noted that any evidence or argument that indicates that one of ordinary skill would not know how to have the claimed loss and loss increase, may be used as evidence in a rejection that the present invention is not enable, or that the claim lack a critical step.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyobe 5262365 in view of Tuminaro 6496627 (or Lemaire) and Baumgart 4820322.

Oyobe discloses the invention except for the deuterium treatment and the overcladding. See Oyobe, col. 16, lines 1- 40. The heat treatment is deemed to be a dehydration (compare to Oyobe col. 12, lines 40-48.)

Tuminaro discloses that deuterium exposure results in improved long term signal attenuation performance. See col. 2, lines 47-60, and col. 3, line 40 to col. 4, line 9. It would have been obvious to improve the long term performance of the Oyobe fiber by exposing it to deuterium as disclosed by Tuminaro.

Baumgart discloses in col. 1 that one can make more fiber by overcladding a preform made by MCVD. That is, one can scale up an MCVD process - but that such requires overcladding with a tube. It would have been obvious to scale up the Oyobe process to make the preforms large 1 (as taught by Baumgart, and including overcladding with a tube) so that one can increase productivity.

For using Lemaire – see how Lemaire is applied above. It would have been obvious to treat the Oyobe fiber as taught by Lemaire to be able to create the fiber devices that Lemaire discloses.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1- 5, 7, 8 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,776,012. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are merely broader in scope. The entire scope of the patent claims is encompassed by the present claims. If one infringes on the patented claims, one necessarily infringes on the claims of issue.

Present claim 1 requires forming, dehydrating, consolidating, drawing and exposing – the patented claim 1 has all those steps.

Claims 2 and 10: Patented claim 4 has all the features.

Claim 3: it is deemed that such is inherent in the patented claim 4 – based on Applicant's disclosure of inherency.

Claim 4: the limitations are in patented claim 1.

Claim 5: patented claim 15 requires all the limitation.

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Claim 7: see patented claim 5.

Claim 8: see patented claim 3.

To the degree that the patented claims require additional steps that the present claims do not, it would have been obvious to delete them if they are not desired. **From MPEP 2144.04**

II. ELIMINATION OF A STEP OR AN ELEMENT AND ITS FUNCTION

A. Omission of an Element and Its Function Is Obvious If the Function of the Element Is Not Desired

Ex parte Wu , 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon diluent. The claims were rejected over a primary reference which disclosed an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

Since the scope of the present claims encompass the entire scope of the patented claims, the double patenting rejection is required so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

Response to Arguments

Applicant's arguments filed 24 June 2005 have been fully considered but they are not persuasive.

It is argued that Tuminaro does not teach exposure at room temperature because Tuminaro discloses treating at non-room temperature for a specified time. This is largely irrelevant because the claims are comprising in nature and are open to addition exposure at other temperatures. The rejection points out where Tuminaro discloses the exposure. The time is not deemed to be very relevant, because the claims do not require any specific duration.

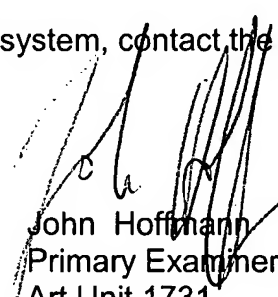
However, it is noted that applicant indicates that the Tuminaro chamber is returned to room temperature with deuterium still in it – but applicant goes on to conclude that this is not exposure at room temperature. Examiner does not understand how Tuminaro's fiber is not necessarily exposed to deuterium at room temperature.

As to the Chang declaration: such fails to demonstrate prior invention. Although it does establish conception of the invention of at least claim one, there is no showing of diligence. As per MPEP 715.07(a): "Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence." The declaration does not provide any evidence of facts establishing diligence.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

8-5-05

jmh